Immunocept, LLC, et al v. Fulbright & Jaworski Doc. 22

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

FILED
JAN 10 2006
CLERK, U.S. DISTRICT COURT
WESTERN DISTRICT OF TEXAS
BY ______ DEPUTY CLERK

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	§	
	§	
Plaintiffs,	§	
	§	
vs.	§	CAUSE NO. A 05 CA 334 SS
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Fulbright.	§	

PLAINTIFFS' REPLY TO FULBRIGHT'S RESPONSE TO PLAINTIFFS' MOTION TO COMPEL TESTIMONY OF SARAH BRASHEARS

TO THE HONORABLE COURT:

COMES NOW Plaintiffs Immunocept, LLC, Patrice Anne Lee, and James Reese Matson (collectively "Plaintiffs") and file this Reply to Fulbright's Response to Plaintiffs' Motion To Compel Testimony of Sarah Brashears and would respectfully show the Court as follows:

I.
SUMMARY OF THE ARGUMENT

The arguments made by Defendant Fulbright & Jaworski ("Fulbright") in its response are unavailing. *First*, because Plaintiffs' Motion seeks relief only against Fulbright – specifically, an order overruling Fulbright's spurious privilege objections – and makes no request that this Court assert any control over Ms. Brashears, this Court is the appropriate forum for the filing of this Motion. *Second*, though Plaintiffs have provided numerous examples of their novel assertion of privilege being accepted in other jurisdictions, Plaintiffs have failed to carry their burden of establishing that such a recognized privilege exists under the applicable law of Texas. *Finally*, whatever privilege may have existed with respect to communications between Fulbright partner

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Tom Paul and Ms. Brashears, Fulbright has waived that privilege by voluntarily disclosing the details of these communications to a third party.

II.
ARGUMENT AND AUTHORITIES

A. Because Plaintiffs Are Only Asking This Court to Assert Control Over Fulbright – a Party-Defendant --This Court is the Appropriate Forum for the Filing of This Motion

Fulbright's argument that this motion should have been filed in a California court wholly rests on mischaracterization of the relief Plaintiffs are seeking with this motion. Specifically, Plaintiffs are not – as suggested by Fulbright – asking this court to assert control over Ms. Brashears. Rather, Plaintiffs are requesting this court to assert its control over Fulbright by overruling Fulbright's spurious privilege objection. This fact was made clear in the heading of Plaintiffs' motion, which specified that it was being filed "against Fulbright & Jaworski."[1]

Plaintiffs readily concede that if the matter at issue in this motion was Mrs. Brashears' personal refusal to answer questions at her deposition, the appropriate forum for the motion would be the Northern District of California. However, what is at issue in this motion is not Ms. Brashears refusal to answer questions. Ms. Brashears did not assert any privilege objections nor did she have counsel present that asserted any privileges on her behalf. Rather, counsel for Fulbright – who were not Ms. Brashears's attorneys and were present at the deposition for same reason as Plaintiffs' counsel, namely, to depose Ms. Brashears – unilaterally invoked privilege on behalf of Fulbright & Jaworski. It is this conduct – the conduct of Fulbright and not Ms. Brashears – that is at issue in this Motion.

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[1] Plaintiffs concede that the title of their Motion is misleading to the extent it appears to suggest that the relief requested from the court is an order that Ms. Brashears submit to deposition testimony. Nevertheless, as this Reply makes clear, the substance of Plaintiffs' requested relief does not consist of such a request. Similarly, language in Plaintiffs' proposed order attached is also misleading in this respect. To clarify any such misunderstandings and make clear the specific relief sought, Plaintiffs are submitting a revised proposed order, attached to this Reply as Exhibit A.

It is well established that courts have authority over the parties in an action pending before them, including the authority to superintend the discovery-related conduct of parties in the context of the pending lawsuit. *See, e.g., Grace & Co. v. Pullman, Inc.*, 74 F.R.D. 80, 84 (D.Okl.1977) (recognizing that a district court where an action is pending has "superintending authority over counsel for the parties in regard to the discovery being conducted in [the] action" and thus may "issue appropriate guidelines in regard to the handling of discovery disputes occurring during depositions" of third-parties). All Plaintiffs' are asking by this motion is that this Court exercise that authority, overrule Fulbright & Jaworski's inappropriate privilege objections, and order Fulbright & Jaworski to cease and desist from asserting such objections in any future deposition of Ms. Brashears. *See* Plaintiffs Proposed Order, attached as Exhibit A. Indeed, it is precisely because (as Fulbright noted in its response) the federal rules of discovery "have a clearly territorial focus" that this Court, not the California court, is the appropriate forum for the resolution of this matter[2]

Once Plaintiffs have obtained such a ruling from this Court, they are aware they will need to seek the re-deposition of Ms. Brashears. Ms. Brashears may or may not agree to submit to that re-deposition. If she does not agree (or if she does agree, and asserts new privilege objections on her own behalf), Plaintiffs will seek appropriate relief from a court with jurisdiction over her. None of this has occurred yet, however. And even if it had, for the reasons discussed above, this Court would still be the proper forum for dealing with the particular question of Fulbright's unilaterally invocation of privilege on its own behalf.

[2] That this Court is the appropriate forum for the resolution of this matter also makes practical sense, since the court resolving this issue will be construing Texas law regarding privilege. *See* Part C, *infra*

B. Plaintiffs Have Provided Ms. Brashears With Notice of this Motion

For the reasons discussed above, this motion does not implicate Ms. Brashears's conduct in the course of her deposition, but is directed solely "against Fulbright & Jaworski's" conduct during that deposition. *See* Plaintiffs Motion to Compel Testimony of Sarah Brashears at 1. For this reason, Plaintiffs did not initially provide Ms. Brashears with notice of their Motion. Nevertheless, to ensure that Plaintiffs have fully complied with even the broadest possible interpretation of Federal Rule of Civil Procedure 37, Plaintiffs will provide Ms. Brashears with notice of this lawsuit by serving her with a copy of their Motion and this Reply on the date this Reply is filed with the Court.

C. Plaintiffs Have Failed to Carry Their Burden of Establishing that the Communications in Question Are Protected by a Recognized Privilege in Texas

Fulbright argues in its Response that Plaintiffs' substantive arguments concerning the applicability of privilege are "unavailing" because Plaintiffs have "failed to cite a single Texas case that suggests communications with a former employee are not protected by [privilege]." However, in making this statement, Fulbright has gotten the burden of proof on this issue completely backward. Under both Texas and federal law, "the party ***asserting*** the privilege bears the burden of establishing its applicability." *Thurmond v. Compaq Computer Corp.*198 F.R.D. 475, 482 (E.D.Tex. 2000)(emphasis added); *see also Huie v. DeShazo*, 922 S.W.2d 920, 926 (Tex. 1996) ("The party resisting discovery bears the burden of proving any applicable privilege."); *Varo, Inc. v. Litton Systems, Inc.*, 129 F.R.D. 139, (N.D.Tex. 1989) ("The burden of proving the existence of an attorney-client privilege or the applicability of the work product immunity doctrine is on the party claiming protection.").

Here, the Federal Rules of Evidence provide that the Texas law of privilege controls. See FED. R. EVID 501; *In re Avantel, S.A.*, 343 F.3d 311 (5th Cir. 2003). Thus, to carry their burden, Fulbright must establish that, under Texas law, conversations between a party or counsel for a party and a former employee for a party nearly ten years removed, are protected from disclosure by the attorney-client or work product privilege. In light of this, Fulbright's argument that no Texas case law exists recognizing the existence of such privilege is not damaging to Plaintiffs' arguments, but rather its own. And while it is true that Texas courts can look to other jurisdictions, including federal law, to provide guidance on issues related to privilege, the law of such other jurisdictions cannot supplant Texas law; seeking guidance from other jurisdictions is only appropriate where the answer is not already supplied by Texas law.

Yet Texas law does provide an answer to the question of whether Fulbright's novel privilege assertion is valid. As discussed in our Motion, the Texas Rules of Evidence specifically delineate the categories of communications protected by attorney-client privilege. *See* Rule 503(b)(1). ***None*** of these specifically listed categories include communications between a party's attorney and a former employee of a party. *Id.* Moreover, by Fulbright's own admission, ***no*** Texas court has ever interpreted any category listed in Rule 503(b) to encompass such communications. The Texas Supreme Court, however, has made it clear that the attorney-client privilege is to be "construed no more broadly than necessary to effectuate its purpose." *Republic Ins. Co. v. Davis*, 856 S.W.2d 158, 160 (Tex. 1993). As the party asserting privilege, Fulbright bears the burden of demonstrating that, despite the lack of any Texas authority supporting its position, this Court should enlarge the scope of recognized privilege in Texas to encompass Fulbright's assertion. Fulbright cannot carry this burden simply by cherry-picking favorable cases from other jurisdictions – each of which has its own unique set of rules and statutes governing the application of privilege in that jurisdiction – and arguing that these decisions should be grafted into Texas law. This is particularly true in light of the Texas Supreme Court directive that the scope of recognized privilege should be carefully construed. *Id.*

Fulbright's argument is further undermined by the fact that purpose of the privilege – to "secure the free flow of information between attorney and client" – would not be served by broadening the scope of recognized privilege in the requested manner. *Republic Ins. Co.*, 856 S.W.2d at 160. There is no indication that a promise of confidentiality would make Ms. Brashears any more or less likely to provide truthful evidence to Fulbright or their counsel, particularly in light of the fact that she is not a named party in this suit nor is Fulbright's counsel representing her for any purpose. Moreover, given the amount of time that has elapsed since her employment with Fulbright & Jaworksi, for all intents and purposes, Ms. Brashears is like any other third-party witness with knowledge of facts relevant to this lawsuit. If privilege does not extend to communications with those other third parties, it makes no sense to extend it to Ms. Brashears, merely because she was once an employee of the Fulbright. Indeed, under Fulbright's view of the law, one hundred hears from now, presumably the privilege would still attach. However, at some point – and over nine years is beyond that point – the relationship of Ms. Brashears to Fulbright as an employee becomes so remote as to negate the privilege. Because the purpose of the privilege would not be served by enlarging its scope to include communications with employees nearly ten years removed from their employment, this Court should accordingly decline to do so. *Id.* (holding that the attorney-client privilege is to be "construed no more broadly than necessary to effectuate its purpose.").

D. Regardless of Whether Fulbright's Asserted "Former Employee" Privilege Exists Under Texas Law, Fulbright Has Waived Privilege With Respect to Conversations Between Tom Paul and Ms. Brashears

Rule 511 of the Texas Rules of Evidence provides that a person upon whom the rules confer a privilege waives that privilege if that person "voluntarily discloses or consents to disclosure of any significant part of the privileged matter unless such disclosure itself is privileged." Tex. R. Evid. 511; *see also Jordan v. Court of Appeals for Fourth Supreme Judicial Dist.*, 701 S.W.2d 644, 649 (Tex. 1985) ("It is the rule in Texas that the protections afforded by a privilege are waived by voluntary disclosure of the privileged [information]."); *Thurmond*, 198 F.R.D. at 482 (holding that "a client may waive the attorney-client privilege by voluntarily disclosing a significant portion of a privileged communication.").

Courts enforce the doctrine of waiver to prevent the selective disclosure of privileged facts "in such way that would be unfair to deny the other party access to other facts relevant to the same subject matter." *Varel v. Banc One Capital Partners, Inc.*, No. CA3:93-CV-1614-R, 1997 WL 86457, *3 (N.D.Tex. February 25, 1997). For example, "courts have recognized subject-matter waiver of work-product in instances where a party deliberately disclosed work-product in order to gain a tactical advantage and in instances where a party made testimonial use of work-product materials and then attempted to invoke the work-product doctrine to avoid cross-examination." *Id.* (citing *United States v. Nobles*, 422 U.S. 225, 228 (1975)). Significantly, in a case where information for which privilege is sought "has been disclosed to a third party, thus raising the question of waiver of the privilege, the party asserting the privilege has the burden of proving that no waiver occurred." *Jordan v. Court of Appeals for Fourth Supreme Judicial Dist.*, 701 S.W.2d 644, 649 (Tex.1985).

Here, Fulbright has voluntarily disclosed the contents of the communications between Tom Paul and Mr. Brashears. This disclosure was made for the express purpose of supporting factual allegations made by Fulbright in its Answer to Plaintiffs' Petition. This disclosure occurred when Marc Deflache, whom Fulbright offered for deposition as its corporate representative, voluntarily provided testimony concerning the contents of these communications at his deposition on October 13, 2005. This testimony was offered by Mr. Deflache in response to questions by Plaintiffs' counsel about certain affirmative defenses asserted by Fulbright in its Answer. Specifically, Mr. Delflache was asked about allegations made in Fulbright's answer that Plaintiffs had failed to mitigate their damages. *See* Deposition of Marc Delflache at 49:3 – 53:14 ("M. Delflache Depo"), attached as Exhibit B. In response, Mr. Delflache testified that it was his understanding, based upon conversations with Tom Paul, that Plaintiffs had consented to having the limiting phrase "consisting of" added to the language of their patent. *See Id* at 50: 3-13; 51:24 – 52:6. He further testified that it was his understanding, also based upon conversations with Mr. Paul, that Plaintiffs had been informed by Ms. Brashears that they could file a continuation of the patent, thereby alleviating the narrowing of the scope of their claims caused by the insertion of the limiting language. *See Id.* at 50: 14-22; 51:24 – 52:6; 61:6-19. Mr. Delflache offered these facts in support of Fulbright's factual allegation that Plaintiffs had known about, and assented to, the narrowing "consisting of" language in the patent, yet had failed to seek ways of broadening that scope by filing a continuation – thereby failing to properly mitigate their damages. *Id.*

When asked how Mr. Paul had acquired such information, Mr. Delflache suggested that it "may" have come from post-employment communications between Mr. Paul and Ms. Brashears. When pressed on the specifics of such conversations, Mr. Delflache stated he could not recall their substance, but encouraged Plaintiffs to ask Ms. Brashears about these conversations in her upcoming deposition:

Deposition Testimony of Mr. Delflache	Record Cite
Q: So, you're taking that on face value? Tom Paul never questioned Sally Brashears specifically about that point? A. Again, I can't recall. I mean, it may be that she, she had those conversations with him directly. You'll have to ask her. I think you're taking her deposition in a few days.	M. Delflache Depo. at 62:2-8.

That Mr. Paul had obtained this information from post-employment conversations with Ms. Brashears was established during Mr. Paul's deposition. There, Mr. Paul indicated that source of the information he had ultimately conveyed to Mr. Delflache had been his post-employment conversations with Ms. Brashears.[3]

Deposition Testimony of Mr. Paul	Record Cite
Q. What did Sally Brashears specifically tell you she had discussed with Dr. Matson and/or Dr. Lee regarding the January, 1996, amendment to the '418 patent? A. She told me she discussed the amendment and why the amendment was in the making and what would happen when the amendment was made. Q. What did she -- did she specifically tell you that she discussed the "consisting of" language? A. I believe she did.	Deposition of Thomas Paul at 144:19 – 145:13 ("T. Paul Depo."), attached as Exhibit C.

[3] The only basis on which Fulbright would permit Plaintiffs counsel to inquire of Mr. Paul concerning the substance of his post-employment communications with Ms. Brashears was under the stipulation that the his answers could not be construed as a waiver of privilege. T. Paul Depo at 125:18 – 126:12 (attached as Exhibit C). To be clear, Mr. Paul's testimony is not being used for this purpose in this Reply. Instead, they are being used to show that the source of the information that Mr. Delflache offered in support of Fulbright's affirmative defense at his deposition was Tom Paul's communications with Ms. Brashears.

Deposition Testimony of Mr. Paul	Record Cite
Q. She told you, "I discussed the 'consisting of' language"? A. I asked her, "What about changing from 'consisting' to 'comprising'"? She said, "I discussed that amendment."	
Q. Now, just to be clear, you did not have any conversations with Sally Brashears at the time that this -- at the time that this amendment occurred regarding the "consisting of" language? A. That is my recollection. Q. Do you know if anybody at Fulbright & Jaworski had any conversations with Sally Brashears in January of 1996 regarding those changes and those amendments that were made to the claim language of the '418? A. I know I didn't have any conversations with her.	*Id.* at 130:2-14

In offering testimony about details learned during post-employment conversations between Mr. Paul and Ms. Brashears, Mr. Delflache, acting as Fulbright's representative, voluntarily disclosed information that Fulbright now asserts is protected by work product privilege. Mr. Delflache did so to gain "tactical advantage" – to provide factual support for specific allegations made by Fulbright that go to the heart of its defense in this case. However, when Plaintiffs attempted (at the express invitation of Mr. Delflache, no less) to make further inquiries into the substance of these communications by asking Ms. Brashears about them at her deposition, Fulbright asserted a privilege objection. In so doing, Fulbright "made testimonial use of work-product materials and then attempted to invoke the work-product doctrine to avoid cross-examination." *Varel,* 1997 WL 86457 at *3. As numerous courts have recognized, such selective disclosure of ostensibly privileged information unfairly hamstrings the other party and thereby constitutes a waiver of privilege with respect to that information. *See, e.g., Thurmond,* 198 F.R.D. at 484 ("[D]efendant cannot make claims as to the results of testing it performed and then use work-product to prevent plaintiffs from making inquiries about its testing process."); *Ginsberg v. Fifth Court of Appeals*, 686 S.W.2d 105, 108 (Tex. 1985) (holding that a party may not "use one hand to seek affirmative relief in court and with the other lower an iron curtain of silence against otherwise pertinent and proper questions which may have a bearing upon his right to maintain his action."). Accordingly, this Court should overrule Fulbright's asserted claim that communications between Mr. Paul and Ms. Brashears are protected by work product privilege.

IV.
CONCLUSION AND PRAYER

Fulbright's objections preventing Ms. Brashears from testifying as to her communications with Mr. Paul and her communications with Fulbright's counsel are without merit and should be overruled. Plaintiffs respectfully request that the Court further enter an order prohibiting Fulbright from asserting such privilege objections at any future deposition of Ms. Brashears. Plaintiffs also respectfully request this Court to award Plaintiffs their reasonable and necessary attorneys' fees and costs associated with the re-deposition of Ms. Brashears. Plaintiffs further pray for such additional relief to which it may be entitled.

Respectfully submitted,

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ATTORNEYS FOR PLAINTIFFS

CERTIFICATE OF CONFERENCE

Counsel for movant and counsel for respondent have personally conducted a conference at which there was a substantive discussion of every item presented to the Court in this motion and despite best efforts the counsel have not been able to resolve those matters presented.

Certified to the 6th day of January, 2006, by

Jeremy A. Fielding

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served as shown below on this the 6th day of January, 2006:

Via Facsimile
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Exhibit A

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	§	
	§	
Plaintiffs,	§	
	§	
vs.	§	**CAUSE NO. A 05 CA 334 SS**
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Defendant.	§	

ORDER GRANTING PLAINTIFFS' MOTION TO COMPEL TESTIMONY OF SARAH BRASHEARS

On this the ___ day of January, 2006, the Court considered Plaintiff's Motion to Compel Testimony of Sarah Brashears against Defendant Fulbright & Jaworski (the "Motion"). Having considered this Motion, the arguments of counsel, and all other matters properly before the Court, the Court is of the opinion that the motion should be GRANTED.

Accordingly, the Court hereby ORDERS that Plaintiffs' Motion to Compel Testimony of Sarah Brashears against Defendant Fulbright & Jaworski is GRANTED.

IT IS THEREFORE ORDERED that (1) Defendant Fulbright & Jaworski's privilege objections asserted during Sarah Brashears deposition concerning communications between Ms. Brashears and Defendant and/or Defendant's counsel are overruled, and (2) Defendant Fulbright & Jarworski shall cease and desist from offering such privilege objections in any future depositions or discovery concerning communications between Sarah Brashears and Defendant and/or Defendant's counsel.

IT IS FURTHER ORDERED that Plaintiffs are awarded costs and attorneys fees associated with the re-deposition of Sarah Brashears in the amount of ______________.

Signed this ______ day of __________, 2006.

____
UNITED STATES DISTRICT JUDGE

Exhibit B

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	)
Plaintiffs,	)
VS.	) CAUSE NO. A 05 CA 334 SS
FULBRIGHT & JAWORSKI, LLP,	)
Defendant.	)

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ORAL AND VIDEOTAPED DEPOSITION OF

MARC DELFLACHE

October 13, 2005

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ORAL AND VIDEOTAPED DEPOSITION OF MARC DELFLACHE, produced as a witness at the instance of the Plaintiffs, and duly sworn, was taken in the above-styled and numbered cause on the 13th day of October, 2005, from 9:03 a.m. to 2:50 p.m., before BECKY LANDERS, CSR, RPR and CRR in and for the States of Texas and California, reported by machine shorthand, at the offices of Beck, Redden & Secrest, One Houston Center, 1221 McKinney Street, Suite 4500, Houston, Texas 77010-2010, pursuant to the Federal Rules of Civil Procedure and the provisions stated on the record or attached hereto.

09:59:11 belief.
09:59:12 A. That's correct.
09:59:14 Q. I'd like to turn to, if I could, some of the
09:59:18 statements that are made in this.
09:59:30 If you look at Interrogatory No. 3, the
09:59:34 answer that's given to this question, "Describe the
09:59:37 legal and factual basis of Fulbright's claim that
09:59:40 plaintiffs failed to exercise reasonable care and
09:59:42 diligence to mitigate their damages."
09:59:44 And then it goes on. The answer is,
09:59:47 "Fulbright has not completed its investigation of the
09:59:50 facts relating to this litigation, and expects the
09:59:54 discovery process to reveal evidence supporting the
09:59:57 cited affirmative defense. The basis of the defense is
09:59:58 that plaintiffs, to the extent they claim the '418
10:00:00 patent does not provide adequate protection, have not
10:00:03 taken appropriate measures to obtain broader patent
10:00:06 protection for their invention?"
10:00:08 Do you see where I'm reading, sir?
10:00:09 A. I do.
10:00:10 Q. Would you tell us what appropriate measures
10:00:12 you believe our client should have taken?
10:00:19 A. Well, I can't speak as to everything that
10:00:22 might come up in the future, but it's my understanding
10:00:24 in this time period that there were discussions around

10:00:30 the time, or maybe even before the '418 patent issued, 10:00:34 based on the desire that your client accelerate the 10:00:39 issuance of the patent. I mean, they wanted a patent, 10:00:43 as I understand it, regardless of the scope of coverage 10:00:45 so that they could get adequate funding and marketing.

10:00:50 It was explained to them, it's my 10:00:51 understanding, that we could, we could take what we've 10:00:54 been given right now and then go -- and then before the 10:00:58 patent issued, we would file a continuation application, 10:01:02 because you can continue the prosecution of an idea in 10:01:06 the Patent Office, even after you get one patent, if you 10:01:11 have different -- the scope of the invention changes and 10:01:14 you want to vary the claims.

10:01:16 So that's one thing that I think was -- 10:01:20 that would support that statement and that those 10:01:22 discussions apparently occurred. It's my understanding 10:01:26 your client was made aware of that opportunity to file a 10:01:28 continuation case or a divisional case or a continuation 10:01:31 in part case following or right before the issuance of 10:01:34 the '418 patent. So they would have been given the 10:01:36 opportunity to continue to prosecute the '418 patent's 10:01:40 child, or grandchild, we call it. That's one example.

10:01:45 Q. Anything else?

A. Another --

10:01:46 Q. I'm sorry. Go ahead.

10:01:47 A. Another example would be the opportunity that exists in the law to go in for a broadened re-issue. I think this patent issued in November of '96. So up until November of '98, your client would have had the opportunity to go in and broaden the scope of its coverage if it felt like it wanted to do that or needed to do that.

10:02:13 And I believe -- it's my understanding that at this point in time that your client had retained at least a second law firm that was prosecuting subsequent applications where the '418 would have been at issue as prior art. I suspect, though, your, your client's subsequent lawyer would have read the patent, should have read the patent and the claims and would have realized that if we wanted to go in to get broader language, because of their earlier desire to get a quick patent and get it issued early, that we could still do that before November of '98.

10:02:48 Q. Anything else?

10:03:06 A. That's all I can think of right now. There may be something else that comes to mind during the course of discussions today. I may want to go back and mention that to you if it comes up.

10:03:15 Q. If it does, let me know.

10:03:17 Where did you -- who had these

10:03:19 discussions about the '418 patent before the issuance related to the scope?
10:03:25 A. It's my understanding that they took place between Ms. Brashears and Dr. Lee and/or Dr. Matson.
10:03:35 Q. How did you learn of this discussion?
10:03:37 A. From my conversations with Tom Paul.
10:03:40 Q. And what did Tom -- how does Tom Paul know that that discussion took place?
10:03:47 A. I don't know how he knows.
10:03:50 Q. Well, was there any tape recording of it --
A. Oh.
10:03:52 Q. -- for example?
10:03:52 A. I'm not aware of that.
10:03:54 Q. Is there a memo in the file that reflects it?
10:03:56 A. I'm not aware of that.
10:03:58 Q. Did you ask him whether there was a memo in the file that reflected this conversation?
10:04:01 A. No. I didn't ask him that.
10:04:02 Q. Did he say that he had talked to Sally Brashears and she had said this?
10:04:07 A. You know, I don't know if he got it firsthand from Sally or how he got it, but he indicated that that was his understanding of what the circumstances were in this time period.
10:04:15 Q. Did you ask him how he learned of this

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10:04:17 discussion with Sally Brashears?

10:04:20 A. I can't recall if I asked him or not. I may
10:04:24 have.

10:04:24 Q. Okay.

10:04:24 A. But I felt comfortable enough from my
10:04:27 discussion with him that I felt it was authoritative.

10:04:30 Q. Well, when you were trying to investigate the
10:04:34 source of Tom Paul's knowledge of this discussion,
10:04:40 you're telling me that you are not aware of Tom Paul
10:04:44 actually talking directly with Sally Brashears?

10:04:46 A. I am not -- I can't recall right now if he
10:04:48 said he talked to her or not. That's what I'm saying.
10:04:50 He may have told me that, and I just can't remember.
10:04:52 But, but he was the source of this information for me.

10:04:56 Q. Did he tell you that his source were the
10:04:58 lawyers in this case?

10:05:00 A. No. He didn't say that.

10:05:01 Q. Then did he tell you that he had had the
10:05:04 actual discussion with Sally Brashears?

10:05:06 A. Again, I can't remember that. But I remember
10:05:10 from the conversation that I felt it was authoritative
10:05:13 enough and I felt comfortable enough that I didn't
10:05:17 inquire any further, not that I could have.

10:05:19 Q. Did you ask Mr. Paul what Dr. Lee actually
10:05:23 said?

10:13:14 Q. Do you know whether there was any
10:13:15 communication to that effect or do you --
10:13:16 A. I'm not aware of any, but there may be. I
10:13:19 didn't look for that in the file here in the last few
10:13:21 days.
10:13:21 Q. Now, with respect to the continuation of the
10:13:23 prosecution --
10:13:23 A. Uh-huh.
10:13:24 Q. -- I understood you to say that Fulbright &
10:13:30 Jaworski told our -- my client that they could, they
10:13:34 could have gone to a continuation of the, of the patent
10:13:39 application in order to, perhaps, broaden its scope?
10:13:44 A. If they wanted to continue prosecuting it,
10:13:47 yes.
10:13:47 Q. And who was it that actually told my clients
10:13:51 that?
10:13:51 A. It's my understanding from my conversation
10:13:53 with Tom Paul that that was a discussion that took place
10:13:57 with Sally Brashears.
10:13:59 Q. And you're telling me, as far as you know, Tom
10:14:01 Paul has not talked to Sally Brashears about that?
10:14:03 A. Again, I couldn't recall, as I said earlier,
10:14:07 where that -- whether he told me he had those direct
10:14:10 discussions or not. But, again, I felt that, you know,
10:14:12 his source was authoritative enough that I felt

10:14:14 comfortable relying on it.
10:14:15 Q. So, so you're taking that on face value? Tom
10:14:18 Paul never questioned Sally Brashears specifically about
10:14:22 that point?
10:14:23 A. Again, I can't recall. I mean, it may be that
10:14:25 she, she had those conversations with him directly.
10:14:28 You'll have to ask her. I think you're taking her
10:14:30 deposition in a few days.
10:14:31 Q. Was that an attempt on, on Fulbright's part,
10:14:34 as you understand it as the representative of Fulbright &
10:14:37 Jaworski, to alert my client to the narrow scope of the
10:14:40 patent that was actually issued?
10:14:44 A. No, because you're assuming the scope is
10:14:45 narrow. I'm just telling you what I understood would be
10:14:50 instances to mitigate damages based on your allegation
10:14:53 that the, the claim is narrow. I mean...
10:14:57 Q. I thought you told me that, that according to
10:15:00 Tom Paul -- you don't know where he got the
10:15:02 information -- that my client was notified that there
10:15:04 was a continuation, a continuation process that they
10:15:08 could have taken advantage of; is that correct?
10:15:12 A. Yes. And they could have taken advantage
10:15:14 of --
Q. No.
10:15:14 A. -- if they wanted --

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,

Plaintiffs,

VS.

FULBRIGHT & JAWORSKI, LLP,

Defendant.

CAUSE NO. A 05 CA 334 SS

****

REPORTER'S CERTIFICATION
DEPOSITION OF MARC DELFLACHE
October 13, 2005

****

I, BECKY LANDERS, Certified Shorthand Reporter in and for the States of Texas and California, hereby certify to the following:

That the witness, MARC DELFLACHE, was duly sworn by the officer and that the transcript of the oral deposition is a true record of the testimony given by the witness;

That the deposition transcript was submitted on ____________ to the witness or to the attorney for the witness for examination, signature and return to me by ____________;

That the amount of time used by each party at the deposition is as follows:

Mr. Michael P. Lynn - 3 hours and 53 minutes;

That $__________ is the deposition officer's charges to Mr. Michael P. Lynn, Counsel for Plaintiffs, for preparing the original deposition transcript and any copies of exhibits;

I further certify that I am neither counsel for, related to, nor employed by any of the parties or attorneys in the action in which this proceeding was taken, and further that I am not financially or otherwise interested in the outcome of the action.

Certified to by me this 24th day of October, 2005.

BECKY LANDERS, CSR, RPR, CRR
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Expiration Date: 6/30/06
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Exhibit C

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON, Plaintiffs,	)	
VS.	)	CAUSE NO. A 05 CA 334 SS
FULBRIGHT & JAWORSKI, LLP, Defendant.	)	

****

VIDEOTAPED / REAL-TIMED DEPOSITION OF

THOMAS D. PAUL

DECEMBER 14, 2005

COPY

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VIDEOTAPED / REAL-TIMED DEPOSITION of THOMAS D. PAUL, produced as a witness at the instance of the Plaintiffs, and duly sworn, was taken in the above-styled and numbered cause on the 14th day of December, 2005, from 2:12 p.m. to 5:52 p.m., before PAT ENGLISH-ARREDONDO, CSR, RMR, CRR in and for the State of Texas, reported by machine shorthand, at the offices of Beck, Redden & Secrest, One Houston Center, 1221 McKinney, Suite 4500, Houston, Texas, pursuant to the Federal Rules of Civil Procedure; that the Witness will read the deposition and sign before any Notary Public.

EXHIBIT
tabbies
C

04:44:25 we can't go forward.

04:44:26 MR. FIELDING: Here's what I will say, 04:44:29 is to the extent it was already opened, I'm not going 04:44:31 to -- in other words, Jeff, I'm not going to waive my 04:44:33 right to argue that we have the right.

04:44:34 I don't want any prejudice from me 04:44:37 agreeing to this waiver. I mean, I'm fine with doing 04:44:39 that so long as it doesn't prejudice us because, as you 04:44:42 know, we don't believe such a privilege exists with 04:44:45 respect to conversations between Mr. Paul and 04:44:47 Ms. Brashears, particularly when --

04:44:49 MR. GOLUB: But that's a different issue. Whether you believe the privilege exists in the 04:44:53 first instance is different than you arguing that by 04:44:53 Mr. Paul discussing it today on the deposition, it 04:44:56 constitutes a waiver.

MR. FIELDING: No, I --

04:44:57 MR. GOLUB: If you will agree that 04:44:58 Mr. Paul is not -- him discussing it in the deposition 04:45:02 today is not a waiver of discussions that Fulbright has 04:45:09 had with Ms. Brashears or others as part of their 04:45:11 investigation of this case, then I will let him answer 04:45:14 the question regarding his communications with 04:45:17 Ms. Brashears --

MR. FIELDING: Okay.

04:45:18 MR. GOLUB: -- to the extent those communications were the basis for Mr. Delflache's testimony as a 30(b)(6) deponent. And that's all. If you will make that stipulation.

04:45:29 MR. FIELDING: Are those the only conditions under which you will allow me today to ask those questions of Mr. Paul?

04:45:35 MR. GOLUB: Yeah. If you're going to come out of this and I let Mr. Paul discuss this and then you argue that Mr. Paul's discussions today are a further waiver, then I'm not going to let him discuss it.

MR. FIELDING: Okay. I just want --

04:45:44 MR. GOLUB: I think that's a reasonable accommodation.

04:45:46 MR. FIELDING: I just want to make sure that I understand it. That apart from this -- unless I agree to those conditions, you will not allow him to answer any questions?

04:45:54 MR. GOLUB: Unless you agree that his discussion with Ms. Brashears does not constitute waiver, I'm not going to let him relay those discussions with Ms. Brashears.

MR. FIELDING: Okay.

04:46:05 MR. GOLUB: Otherwise, I will be facing

04:48:47 MR. GOLUB: Okay.
04:48:56 Q. (By Mr. Fielding) Now, just to be clear, you did not have any conversations with Sally Brashears at the time that this -- at the time that this amendment occurred regarding the "consisting of" language?
04:49:10 A. That is my recollection.
04:49:12 Q. Do you know if anybody at Fulbright & Jaworski had any conversations with Sally Brashears in January of 1996 regarding those changes and those amendments that were made to the claim language of the '418?
04:49:26 MR. GOLUB: Calls for speculation.
04:49:27 A. I know I didn't have any conversations with her.
04:49:37 Q. (By Mr. Fielding) Are you aware of anyone else who did?
04:49:40 A. All I know is I didn't have conversations. I don't know what other conversations she had or didn't have.
04:49:45 Q. I understand. I'm just saying: Are you aware of anyone else who did? Has anybody ever told you that they had a conversation with Sally Brashears about that specific amendment made in January of 1996 to the '418 patent?
04:49:56 A. I never asked anybody.

05:06:21 with them for an hour. And in an hour and five pages,
05:06:26 if you want to do your math, that's at least 20 pages;
05:06:29 and a lot of the stuff is less than that because most
05:06:30 of it is stuff that wouldn't be discussed.
05:06:32 Q. So you were speculating as to what may have
05:06:35 been discussed?
05:06:35 A. No. I'm saying the whole Office Action was
05:06:37 discussed.
05:06:38 Q. Let me just make sure I understand your
05:06:39 thought process. You read "Telephone conference with
05:06:42 P. Lee. Re: Office Action response and Office
05:06:44 Action," and from that you're extrapolating that they
05:06:46 would have discussed everything in the Office Action.
05:06:48 Is that correct?
05:06:49 A. Everything of relevance, yes.
05:06:50 Q. But you weren't there; so you simply don't
05:06:52 know, do you, sir?
05:06:53 A. I wasn't there.
05:07:01 Q. Now, you said that Sally Brashears told you
05:07:03 that she had discussed this. What did Sally Brashears
05:07:06 specifically tell you she had discussed with Dr. Matson
05:07:11 and/or Dr. Lee regarding the January, 1996, amendment
05:07:15 to the '418 patent?
05:07:18 MR. GOLUB: And, again, this is subject
05:07:18 to our stipulation, correct?

05:07:20 MR. FIELDING: Yes.
05:07:21 A. She told me she discussed the amendment and why the amendment was in the making and what would happen when the amendment was made.
05:07:34 Q. (By Mr. Fielding) What did she -- did she specifically tell you that she discussed the "consisting of" language?
05:07:41 A. I believe she did.
05:07:42 Q. She told you, "I discussed the 'consisting of' language"?
05:07:45 A. I asked her, "What about changing from 'consisting' to 'comprising'"?
05:07:49 She said, "I discussed that amendment."
05:07:50 Q. Did she tell you that she had a specific recollection of that conversation?
05:07:55 A. I believe she did.
05:07:56 Q. If she testified later that she did not have a specific recollection of that conversation, would that be inconsistent with what she told you when you talked to her about it?
05:08:04 A. I can only tell you what she told me.
05:08:12 Q. Did Ms. Brashears tell you that she explained to -- that she explained the effect that the insertion of the "consisting of" language would have on the scope of the '418 patent with Dr. Matson and Dr. Lee?

THE STATE OF TEXAS :
COUNTY OF HARRIS :

I, Pat English-Arredondo, CSR, RMR, CRR, a Certified Shorthand Reporter and Notary Public in and for the State of Texas, do hereby certify that the facts as stated by me in the caption hereto are true; that the above and foregoing answers of the witness, **THOMAS D. PAUL**, to the interrogatories as indicated were made before me by the said witness after being first duly sworn to testify the truth, and same were reduced to typewriting under my direction; that the above and foregoing deposition as set forth in typewriting is a full, true, and correct transcript of the proceedings had at the time of taking of said deposition.

I further certify that I am not, in any capacity, a regular employee of the party in whose behalf this deposition is taken, nor in the regular employ of his attorney; and I certify that I am not interested in the cause, nor of kin or counsel to either of the parties.

GIVEN UNDER MY HAND on this, the 16th day of December, 2005.

Pat English-Arredondo, RMR/CRR

PAT ENGLISH-ARREDONDO, CSR, RMR, CRR
Texas CSR No.: 3828
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